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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Richard A. Fiedotin *et al.*	Confirmation No.: 3747
Serial No. 09/487,932	Group Art Unit: 3626
Filed: January 20, 2000	Examiner: Cobanoglu, Dilek B.
For: *Method and System for Providing Current Industry Specific Data to Physicians*	Attorney Docket No.: 061018-0007-US

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APPELLANTS' BRIEF UNDER 37 C.F.R. § 41.37

This Appeal Brief, in conjunction with the previously filed Notice of Appeal, appeals the 35 U.S.C. § 103 rejections of claims 45-66 and 89-91 by the United States Patent and Trademark Office in a Final Office Action dated February 14, 2008. The Notice of Appeal was filed on May 13, 2008.

As shown herein, Appellants demonstrate that independent claim 45 includes claim limitations not taught by the cited references of Falchuk et al, (U.S. Patent No. 6,256,613), Bauer et al. (U.S. Patent No. 5,884,325) and Pang (U.S. Patent No. 6,493,007 Bl) and, thus, the rejection under 35 U.S.C. § 103 cannot be sustained.

The fee required under 37 C.F.R. § 41.20(b)(2) is being filed concurrently herewith.

The Commissioner has been authorized through the electronic filing system to charge any additional fees or credit any overpayment associated with this communication to Deposit Account No. 50-0310 (order No. 061018-0007-US).

Table of Contents

I.   THE REAL PARTY IN INTEREST

The real party in interest in this appeal is Epocrates Inc., the assignee of this application.

II. RELATED APPEALS AND INTERFERENCES

Appellants are not aware of any appeals, judicial proceedings, or interferences that may be related to, directly affect, or be directly affected by or have a bearing on the Board's decision in this pending appeal.

III.   STATUS OF THE CLAIMS

The status of the claims is as follows:

- Claims canceled: 1-44.

- Claims withdrawn from consideration but not cancelled: 67-88.

- Claims pending: 45-66 and 89-91.

- Claims rejected: 45-66 and 89-91.

- Claims appealed: 45-66 and 89-91.

IV.   STATUS OF AMENDMENTS

All amendments have been entered. A copy of the appealed claims is attached as Section VIII, "Claims Appendix."

V.   SUMMARY OF THE CLAIMED SUBJECT MATTER

This application has one pending independent claim, claim 45, whose subject matter is described below.

A.   The Subject Matter as Claimed in Independent Claim 45

The subject matter of this application, as described in the specification is generally directed to a method for distributing medical information stored on a computer system to a group of physicians. Support for the claim elements of the sole independent claim, claim 45, is provided in the following paragraph. By way of background, the specification describes that in one embodiment, information is presented to the physicians in the form of interactive messages that are downloaded and stored each time a physician performs a synchronization of his or her handheld device.[1] Physicians may view and interactively respond to these messages at their leisure.[2] The interactive messages are customized specifically for an identified group of physicians.[3] Because the interactive messages are customized, the physicians receive content relevant to their specialties or interests.[4] Customizing also enables targeted marketing capabilities, such as for enrolment in clinical trials *etc.*[5]

The claimed subject matter of claim 45 is a method for distributing medical information stored on a computer system to a group of physicians.[6] The steps outlined below are performed at a server in the computer system.[7] First, a group of physicians is identified from

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[1] Application specification page 20, lines 23-25.

[2] Application specification page 20 line 25.

[3] Application specification page 20, lines 22-23 and page 21, lines 20-22.

[4] Application specification page 20, lines 25-27.

[5] Application specification page 20, lines 25-27.

[6] Application specification page 11, line 6 – page 15, line 4; page 8, lines 24-25; page 20, lines 21-23; and Figure 1, elements 100, 114, and 116-124.

[7] Application specification page 11, line 6 – page 12, line 16; page 13, line 5 – page 14, line 20; and Figure 2, element 200.

multiple physicians.[8] Then, an interactive message is generated.[9] Generating the interactive

message comprises customizing at least a portion of the medical information stored on the

computer system to the identified group of physicians.[10] Generating the interactive message also

comprises including objects in the message that physicians in the group can select to respond to,

or dispose of, the interactive message.[11] Thereafter, a synchronization signal is received at the

server, from a respective handheld computing device operated by a respective physician of the

group of physicians.[12] The synchronization signal indicates an availability of the respective

handheld computing device for receipt of the interactive message.[13] Then, the interactive

message is automatically transmitted from the computer system to the respective handheld

computing device in response to the synchronization signal.[14]

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[8] Application specification page 21, lines 20-22.
[9] Application specification page 20, lines 21-23.
[10] Application specification page 20, lines 21-27 and page 21, line 20.
[11] Application specification page 20, lines 30-34; page 21, lines 5-15; and Figures 4A-4D.
[12] Application specification page 13, line 7- page 14, line 6; page 20, lines 23-25; page 21, lines 23-27; and Figure 2.
[13] Application specification page 11 line 6 – page 13, line 6; page 13, line 7- page 14, line 6; Figure 1; and Figure 2.
[14] Application specification page 13, line 7- page 14, line 6; page 20, lines 21-30; page 21, lines 23-27; and Figure 2.

VI.   GROUNDS OF REJECTION PRESENTED FOR REVIEW

Examiner Cobanoglu has rejected all of the pending claims under 35 U.S.C. § 103.

A.   The § 103 Rejection of the Claim 45 in the 2/14/08 Office Action

The Examiner rejected Claims 45-61, 63, 64, 66, and 89-91 under 35 U.S.C. § 103(a) as
being unpatentable over Falchuk et al, (U.S. Patent No. 6,256,613) (hereinafter "Falchuk"),
Bauer et al. (U.S. Patent No. 5,884,325) (hereinafter "Bauer"), and further in view of Pang (U.S.
Patent No. 6,493,007 Bl) (hereinafter "Pang").

With regard to independent claim 45, the Examiner stated on pages 2-3 of the Office
Action mailed 2/14/2008 (hereinafter "Office Action") that:

> A. Claim 45 is amended now to recite a method for distributing medical
> information stored on a computer system to a group of physicians (Falchuk;
> abstract, col. 2, lines 11-21), the method comprising:
> > i. At a server in said computer system:
> > > (1) identifying a group of physicians from multiple physicians
> > > (Falchuk; col. 3, lines 11-46);
> > > (2) generating an interactive message comprising: customizing
> > > at least a portion of said medical information stored on the
> > > computer system to said identified group (Falchuk; col. 5, lines 35-
> > > 47, col. 6, lines 11-17); and including objects that physicians in the
> > > group can select to respond to, or dispose of, the interactive
> > > message;
> > > (3) receiving, at the server, a synchronization signal from a
> > > respective handheld computing device operated by a respective
> > > physician of the group of physicians, wherein said synchronization
> > > signal indicates an availability of said respective hand held
> > > computing device for receipt of said interactive message; and
> > > (4) in response to said synchronization signal, automatically
> > > transmitting said interactive message from the computer system to
> > > said respective hand held computing device.

The Examiner admits that "Falchuk fails to expressly teach receiving, at the server, a synchronization signal from a respective handheld computing device."[15] The Examiner instead relies on Bauer; abstract, col. 1, line 59 to col. 2, line 5, col. 3, lines 1-11, col. 6, lines 13-21, and col. 11, lines 17-35 as purportedly teaching this element.[16]

Similarly, the Examiner admits that "Falchuk does not explicitly disclose interactive message comprising: including objects that the physicians (or users) can select to respond to, or dispose of, the interactive message." Instead, the Examiner relies on Pang; col. 3, lines 19-62, and figure 5, items 514, 519 as purportedly teaching this element.[17]

B.   The Examiner's Response to Arguments

The Examiner further states in the Response to Arguments section (pages 16-17) of the Office Action that:

> Applicant's arguments filed 11/21/2007 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear.
> A. In response to Applicant's argument about Falchuk does not teach "at a server in said computer system, identifying a group of physicians from multiple physicians", Examiner respectfully submits that Falchuk teaches "A supervisory computer 10 used in the preferred embodiment of the invention operates as illustrated in FIG. 1 to perform three principal concurrent functions: (1) it manages and records a consultation session between a primary care physician and a selected specialist, both of whom are typically geographically remote from the host computer; (2) it both uses and augments a database of medical information which includes a collection of case study items, each containing information which was utilized during the course of a given consultation session; and (3) it builds and uses a database of "learning events" associated with each participating primary care physician, thereby creating reports for participating physicians which certify their participation in consultation sessions entitling them to continuing medical education credits." And ". . . The supervisory computer 10 is typically located remotely from the client computer 20 and serves a large number of client computers in client/server relationship" in col. 3, lines 12-46.

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[15] Office Action, page 3.
[16] Office Action, page 4.
[17] Office Action, page 4.

C.   Summary of Rejections of Claim 45

For this appeal, Appellants present for review the limitations of independent claim 45:

- "at a server in said computer system: identifying a group of physicians from multiple physicians," which the Examiner argues is taught by Falchuk; col. 3, lines 11-46;

- "at a server...generating an interactive message comprising: customizing at least a portion of said medical information stored on the computer system to said identified group," which the Examiner argues is taught by Falchuk; col. 5, lines 35-47, and col. 6, lines 11-17;

- "at a server: ...generating an interactive message comprising: ...including objects that physicians in the group can select to respond to, or dispose of, the interactive message," which the Examiner argues is taught by Pang; col. 3, lines 19-62, and figure 5, items 514, 519;

- "receiving, at the server, a synchronization signal from a respective handheld computing device operated by a respective physician in a group of physicians," which the Examiner argues is taught by Bauer; abstract, col. 1, line 59 to col. 2, line 5, col. 3, lines 1-11, col. 6, lines 13-21, and col. 11, lines 17-35; and

- "in response to said synchronization signal, automatically transmitting said interactive message from the computer system to said respective handheld computing device," which the Examiner does not presently argue is taught in any of the references.

D.   The § 103 Rejection of the Claims 46, 51, 57, and 61

The Examiner has also rejected dependent claims 46, 51, 57, and 61 as follows:

- Dependent claim 46 recites, *inter alia*, that "said identifying is based on information selected from the group consisting of: a practice area of each respective physician of the group of physicians; a number of prescriptions written by each respective physician; a Drug Enforcement Agency number of each respective physician, a medical education number of each respective physician, and any combination of the aforementioned."[18] The Examiner cites Falchuk, Column 3, lines 47-52 and Column 5, lines 48-54 as purportedly disclosing this element.[19]

- Dependent claim 51 recites, *inter alia*, that "the interactive message includes an inquiry whether said physicians wish to receive Continuing Medical Education (CME) at the handheld computing device."[20] The Examiner cites that Falchuk Column 5, lines 48-58 as purportedly teaching this element. [21]

- Dependent claim 57 recites, *inter alia*, that "said generating further comprises associating an expiration date with said interactive message, such that said interactive message expires after a predetermined time and is thereafter removed from said respective handheld computing devices."[22] The Examiner cites Falchuk, Column 4, lines 53-61 as purportedly disclosing this element.[23]

- Dependent claim 61 recites, *inter alia*, that the "handheld computing device is configured to store a set maximum amount of messages at any one time."[24] The Examiner cites Bauer, Column 1, lines 51-58, Column 3, lines 1-11, Column 4

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[18] Claim 46.
[19] Office Action, page 6.
[20] Claim 51.
[21] Office Action, page 6.
[22] Claim 57.
[23] Office Action, page 8.
[24] Claim 61.

lines 12-25, Column 6, lines 13-21, and Column 11, lines 17-35 as purportedly disclosing this element.[25]

E.   Summary of Rejections

Appellants will demonstrate that most limitations of claims 45, 26, 51, 57, and 61 are not taught by the cited references. Appellants seek to streamline the appeal process by focusing on these limitations alone, but by doing so Appellants do not acquiesce or admit to the correctness or appropriateness of any characterizations of the inventions, statements, rejections, objections, or any other issues raised by the Examiner.

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[25] Office Action, page 10.

VII. ARGUMENT

Appellants argue that the following limitations of claim 45 are not taught in Falchuk, Bauer, or Pang: "at a server in said computer system: identifying a group of physicians from multiple physicians", "at a server…generating an interactive message comprising: customizing at least a portion of said medical information stored on the computer system to said identified group", "at a server…generating an interactive message comprising: …including objects that physicians in the group can select to respond to, or dispose of, the interactive message", "receiving, at the server, a synchronization signal from a respective handheld computing device operated by a respective physician of the group of physicians", and "in response to said synchronization signal, automatically transmitting said interactive message from the computer system to said respective handheld computing device".

Furthermore, Appellants argue the dependent claims 46, 51, 57, and 61 include additional limitations not taught by Falchuk, Bauer, or Pang.

Accordingly, Appellants argue that it would not have been obvious to one of skill in the art to combine the teachings of Falchuk, Bauer, and Pang, and that even if the teachings were combined they would not disclose the claimed inventions.

A. Law regarding rejections under 35 U.S.C. § 103

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966); see also *KSR Int'l Co. V. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). "Section 103 forbids issuance of a patent when the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR*, 127 S.Ct. at 1734 (internal quotations omitted). Thus, to be

patentable, the differences between the claimed subject matter and the prior art must be substantial enough to not be obvious to a person of ordinary skill in the art.

B.   **Falchuk, Bauer, and Pang do not teach "at a server in said computer system: identifying a group of physicians from multiple physicians."**

Independent claim 45 is repeated below for ease of reference:

> A method for distributing medical information stored on a computer system to a group of physicians, the method comprising:
>> at a server in said computer system:
>>> identifying a group of physicians from multiple physicians;
>>>> generating an interactive message comprising:
>>>>> customizing at least a portion of said medical information stored on the computer system to said identified group; and
>>>>> including objects that physicians in the group can select to respond to, or dispose of, the interactive message;
>>>> receiving, at the server, a synchronization signal from a respective handheld computing device operated by a respective physician of the group of physicians, wherein said synchronization signal indicates an availability of said respective handheld computing device for receipt of said interactive message; and
>>>>> in response to said synchronization signal, automatically transmitting said interactive message from the computer system to said respective handheld computing device.

Independent claim 45 includes the following element, "at a server... <u>identifying a group of physicians</u> from multiple physicians." This element is described in the present specification as follows:

> Messages can be specifically targeted to an individual physician or a group of physicians. Physicians may be identified by their practice areas, number of prescriptions written or even their Drug Enforcement Agency Number (DEA#), or Medical Education Number (ME#).[26]

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[26] Application specification page 21, lines 20-22.

Identification of groups of physicians is helpful for later sending the physicians messages which are customized to that group's particular specialty or interest.[27] It also enables targeted marketing capabilities.[28] Conversely, by identifying a group of physicians from multiple physicians, the physicians who are not identified are not bothered with irrelevant messages.

Each reference is addressed separately below.

1.   Falchuk does not teach "at a server in said computer system: identifying a group of physicians from multiple physicians."

Falchuk does not teach "at a server in said computer system: identifying a group of physicians from multiple physicians"[29] for at least the following reasons.

Falchuk teaches a non-automated system for one primary care physician to communicate with one specialist.[30] The primary care physician is assisted in finding a specialist by a particular process.[31] First, Falchuk teaches that a single <u>primary care physician</u> utilizes a client computer station to formulate a request for consultation.[32] Second, the primary care physician's request is transmitted to the <u>supervisory host computer</u>.[33] Third, the supervisory host computer receives the request from the primary care physician and displays it for initial review by a <u>staff physician</u>.[34] Fourth, the staff physician reviews the request and, if the information is adequate, selects a <u>specialist</u> to handle the request.[35] Finally, the staff physician then forwards the request to the selected specialist.[36]

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[27] Application specification page 20, lines 25-27.
[28] Application specification page 20, lines 25-27.
[29] Claim 45.
[30] Falchuk, Col. 3, lines 12-52.
[31] Falchuk, Col. 3, lines 12-52.
[32] Falchuk, Col. 3, lines 26-29.
[33] Falchuk, Col. 3, lines 26-29.
[34] Falchuk, Col. 3, lines 34-36.
[35] Falchuk, Col. 3, lines 40-48
[36] Falchuk, Col. 3, lines 48-52.

The Examiner cites Falchuk Column 3, lines 11-46 as teaching "identifying a group of physicians..."[37] The Examiner specifically quotes the following statement in Falchuck as disclosing the claimed "identifying" step:

> The supervisory computer 10 is typically located remotely from the client computer 20 and <u>serves</u> a large number of client computers in client/server relationship.[38]

Therefore, it appears that the Examiner equates <u>serving</u> a group of physicians with <u>identifying</u> a group of physicians. While each host computer in Falchuk is capable of serving numerous client computers and numerous requests from any number of primary care physicians, each primary care physician's request is processed separately by a staff physician. The primary care physicians are not "identified" at all; instead the primary care physician must be the first to initiate the contact. After the primary care physician initiates contact to request a consultation, his/her request is processed and eventually sent to the selected specialist. Therefore, Falchuk does not teach "<u>identifying</u> a group of physicians."

Falchuk also fails to disclose that a <u>group</u> of physicians is identified. Each request from a single primary care physician is sent to a <u>single</u> specialist, *i.e.*, neither groups of primary care physicians nor groups of specialists are identified by the staff physician.

Furthermore, in Falchuk, the "identifying" does not occur at the supervisory host computer. Instead, the staff physician identifies the specialist.

In light of the above, it is clear that Falchuk does not disclose, teach, or suggest "<u>at a server</u> in said computer system: <u>identifying</u> a <u>group of physicians</u> from multiple physicians" as required by claim 45.

Unlike Falchuk, claim 45 is not directed to a consultation between a primary care physician and a specialist. Instead, the claim is directed to sending customized medical information to a group of physicians. Figures 4A – 4D show examples of the type of information

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[37] Office Action, page 3.
[38] Falchuk, Col. 3, lines 31-34, emphasis added.

contained in these alerts, *e.g.,* invitations to a speaker series or participation in a clinical trial. By receiving messages customized to their particular interests and specialties, each physician in the group may for example stay abreast of current relevant developments in his/her area of specialty. Falchuk's teachings, however, would not enable the type of communication or the benefits received by the claimed invention because it does not identify a group of physicians, as required by claim 45. As such, the differences between Falchuk and the present claim are substantial.

      2.   **Bauer does not teach "at a server in said computer system: identifying a group of physicians from multiple physicians."**

Independent claim 45 includes the following element, "at a server in said computer system: identifying a group of physicians from multiple physicians."[39] The Examiner does not cite Bauer as teaching this element.

Bauer teaches a database synchronizer which facilitates client-side and server-side applications that share data but do not maintain continuous connections to a single shared data source.[40] It defines synchronization as the act whereby data in two databases are restored to consistency.[41] Bauer states, "[t]he database synchronizer is used to synchronize the data in a central database <u>for a particular client</u> with the data on that client's intermittently-connected computer."[42] The modifications made at one client may eventually be propagated through the server to other clients using the same database.[43]

Bauer teaches synchronizing between <u>one client's intermittently-connected computer</u> (*i.e.,* a portable computer) and a central database containing data relevant to <u>that particular client</u>. Not only does the central database server not "identify" a group of clients, but it also does not "identify a <u>group of physicians</u>." Instead, it synchronizes data with only one client's computer at a time. Although several clients may share data through the server, the server does not identify a "group of clients" from a larger group. It only updates the intermittently-connected computers

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[39] Claim 45.
[40] Bauer, Abstract.
[41] Bauer, Col. 1, lines 50-52.
[42] Bauer, Abstract, emphasis added.
[43] Bauer, Col. 1, lines 21-26.

that are already associated with the shared database, and it does this on an individual basis. Therefore, Bauer does not teach "at a server in said computer system: identifying a group of physicians from multiple physicians.," as required by claim 45.

3. Pang does not teach "at a server in said computer system: identifying a group of physicians from multiple physicians."

Independent claim 45 includes the following element, "at a server in said computer system: identifying a group of physicians, from multiple physicians."[44] The Examiner does not cite Pang as teaching this element.

Pang teaches an improvement over a traditional e-mail system in that it teaches a "method for replying to unsolicited e-mail communications such as SPAM and the like."[45] In its taught method, a selectable icon called "NO SPAM" is displayed near the list of e-mail messages or near the content of the message itself.[46] When the user determines that a message is SPAM and clicks on the "NO SPAM" icon, a reply is sent to the sender which indicates that the user would like to be removed from the distribution list.[47]

Pang simply does not teach "identifying a group of physicians" at a server. The server of Pang does not identify any groups of people or users. Furthermore, it does not specifically teach identifying physicians. All the server does in Pang is to process the incoming messages addressed to the user. For at least the above stated reasons, Pang does not teach "at a server in said computer system: identifying a group of physicians from multiple physicians."

As such, claim 45, and the claims that depend therefrom, is patentable over the cited references, which jointly fail to disclose or suggest the substantial limitations of independent claim 45.

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[44] Claim 45.
[45] Pang, Abstract.
[46] Pang, Col. 7, line 42 – Col. 8, line 22.
[47] Pang, Col. 7, lines 57-67 and Col. 8, lines 16-22.

C. **Falchuk, Bauer, and Pang do not teach "at a server...generating an interactive message comprising: customizing at least a portion of said medical information stored on the computer system to said identified group."**

Independent claim 45 includes the following element, "at a server in said computer system: ...generating an interactive message comprising: <u>customizing</u> at least a portion of said medical information stored on the computer system <u>to said identified group</u>."[48] This element is supported and explained by the specification which states, "[m]essages can be specifically targeted to an individual physician or a group of physicians."[49] The specification also states that the interactive messaging system "provides physicians with timely and relevant information that is customized specifically for an individual physician or group of physicians."[50]

1. **Falchuk does not teach "at a server...generating an interactive message comprising: customizing at least a portion of said medical information stored on the computer system to said identified group."**

Falchuk does not teach "at a server in said computer system: ...generating an interactive message comprising: <u>customizing</u> at least a portion of said medical information stored on the computer system <u>to said identified group</u>." Falchuk teaches sending a message from a primary care physician to a specialist and vice versa through a supervisory host monitored and controlled by a staff physician.[51] The staff physician may also forward selected medical information which may be relevant to the request along with the request from the primary care physician to the specialist.[52] Neither the requests nor the selected medical information are interactive messages, nor are they customized to a group of physicians, as required by claim 45.

The Examiner cites Falchuk Column 5, lines 35-47 and Column 6, lines 11-17 as teaching "generating an interactive message comprising: <u>customizing</u> at least a portion of said medical information stored on the computer system <u>to said identified group</u>."[53] The cited

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[48] Claim 45.
[49] Application specification page 21, lines 20-22.
[50] Application specification page 20, lines 21-23.
[51] Falchuk, Col. 3, lines 12-52.
[52] Falchuk, Col. 3, lines 47-52.
[53] Office Action, page 3.

Column 5 paragraph deals with "clarification requests."[54] A "clarification request" is sent from a primary care physician.[55] Each "clarification request" is examined by the staff physician, and then, if appropriate, transmitted to the specialist for further comments.[56] The cited Column 6 paragraph deals with "pending responses" that a primary care physician may receive from the supervisory host.[57] These "pending responses" include requests for additions to prior consultation requests, requests for corrections to prior consultation requests, clarifying comments from specialists, and pending examinations to be completed to fulfill CME requirements.[58]

Falchuk's "Clarification requests" come from an individual primary care physician.[59] They are processed by the staff physician at the supervisory host (server.) The "clarification requests" do not initiate at the server, as claimed. They are initiated by the primary care physician. Furthermore, "clarification requests" are directed to a particular specialist, they are not sent to a group of specialists. "Clarification requests" are not customized for an identified group of physicians. Thus, Falchuk fails to teach "customized... to said identified group." Finally, "clarification requests" are not interactive messages. They are general e-mail messages without interactive components within the messages.

For similar reasons as those cited above, these "pending responses" are not "interactive messages" customized to an identified group of physicians. Some of the "pending responses" come directly from the specialist – such as "clarifying comments from specialist in response to a prior clarification request." Some "pending responses" come from the primary care physician, such as additions or correction to prior consultations. Neither of these "pending responses" are initiated "at the server." Therefore, the only "pending response" that may initiate at the server is a "pending examination to be completed to fulfill CME requirements." However, the CME credit information is sent to an individual primary care physician who is logged onto the system,

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[54] Falchuk, Col. 5, lines 34-47.
[55] Falchuk, Col. 5, lines 34-37.
[56] Falchuk, Col. 5, lines 39-44.
[57] Falchuk, Col. 6, lines 11-13.
[58] Falchuk, Col. 6, lines 11-17.
[59] Falchuk, Col. 5, lines 34-37.

not to an identified <u>group of physicians</u>.[60] Similarly, the CME credit information is particular to individual primary care physician, not to an <u>identified group of physicians</u>. Finally, "CME credit information" is not <u>interactive</u>. It includes a form to be completed, but does not include <u>interactive components within the message</u>.[61]

The differences between Falchuk's "clarification requests" or "pending responses" and the claimed "interactive messages comprising: customized ... medical information" are substantial. Falchuk teaches that the "customized messages" are particular to a specialist. It teaches that "pending responses" are particular to a primary care physician. Neither is "customized... to an identified <u>group</u>" of physicians. Claim 45 instead focuses on information relevant to the identified <u>group</u> of physicians.

Furthermore, the messages of the claimed invention are "<u>interactive</u>." In other words, they can be immediately dealt with by clicking on an imbedded object to receive more information or to dispose of the message. The benefit of this interactive component is that the message can be quickly and easily dealt with by the physician receiving it. The physician need not read attachments and supporting materials. Falchuk, on the other hand, assumes that the primary care physician and the specialist may need a wealth of information in order to deal with a particular request. As such, Falchuk not only sends the messages back and forth between the specialist and the primary care physician, but also sends "selected materials" which may be relevant to the request. Therefore, the whole tenor of Falchuk is directed to providing a large amount of information to the physicians, rather than a small targeted alert.

Therefore, for at least the above reasons Falchuk does not teach "<u>at a server</u> in said computer system: generating an <u>interactive message</u> comprising: <u>customizing</u> at least a portion of said medical information stored on the computer system <u>to said identified group</u>" as required by claim 45.

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[60] Falchuk, Col. 5, lines 48-66.
[61] Falchuk, Col. 5, lines 57-61.

> **2.   Bauer does not teach "at a server...generating an interactive message comprising: customizing at least a portion of said medical information stored on the computer system to said identified group."**

Independent claim 45 includes the following element, "at a server...generating an interactive message comprising: customizing at least a portion of said medical information stored on the computer system to said identified group."[62] The Examiner does not cite Bauer as teaching this element.

Bauer teaches only a synchronization process between client-side and server-side applications that share data.[63] As stated above, this synchronization process occurs for one client at a time.[64] Because Bauer does not teach "identifying a group of physicians," it is incapable of further teaching "generating an interactive message... customiz[ed] ... to [the] identified group." In other words, the server itself does not generate particular messages for <u>an identified group</u> of clients, because it only synchronizes with each client individually.

If the server of Bauer detects any conflicts between one client's data and the server data, it resolves the conflicts and then propagates modifications back to that client as "refresh data."[65] Bauer does not teach <u>customizing</u> any information to a group of clients. At most, Bauer teaches individualized "refresh data," which is just resolved conflicts between the particular client data and server data, rather than a "customized" interactive message containing medical information. Also, Bauer's "refresh data" is not "<u>interactive</u>" because the client just receives the data with conflicts resolved rather than receiving a message with an "interactive" component. Furthermore, Bauer does not teach dealing with <u>medical information</u>. Therefore, Bauer does not teach "at a server... generating an <u>interactive message</u> comprising: <u>customizing</u> at least a portion of said <u>medical information</u> stored on the computer system <u>to said identified group</u>."

> **3.   Pang does not teach "at a server...generating an interactive message comprising: customizing at least a portion of said medical information stored on the computer system to said identified group."**

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[62] Claim 45.
[63] Bauer, Abstract.
[64] See argument above.
[65] Bauer, Col. 2, lines 20-22.

Independent claim 45 includes the following element, "at a server...generating an interactive message comprising: customizing at least a portion of said medical information stored on the computer system to said identified group."[66] The Examiner does not cite Pang as teaching this element.

Pang does not teach "generating an interactive message" at the server. As stated above, Pang only teaches a server that processes messages from a sender to a user.[67] It does not teach a server that "generates" any messages itself. Also, the messages that the user receives from the server in Pang are not "interactive." They are traditional e-mail messages with buttons around the periphery that the user can choose to use, but the message itself is not "interactive." Furthermore, because Pang does not identify a group of physicians, the messages that Pang's server processes cannot be sent to the identified group. Finally, Pang teaches nothing about medical information, so it cannot teach customizing a message with "medical information." For at least the above stated reasons Pang does not teach "at a server... generating an <u>interactive</u> <u>message</u> comprising: <u>customizing</u> at least a portion of said <u>medical information</u> stored on the computer system <u>to said identified group</u>."

D.   **Falchuk, Bauer, and Pang do not teach "at a server...generating an interactive message comprising: ...including objects that physicians in the group can select to respond to, or dispose of, the interactive message."**

Independent claim 45 includes the following element, "at a server...generating an interactive message comprising: ...including objects that physicians in the group can select to respond to, or dispose of, the interactive message."[68] This element is supported and explained in the specification which states, "[m]essages preferably consist of text, <u>buttons</u> and/or graphics.[69] Examples of the messages, with interactive buttons, are shown in Figures 4A and 4C. Figure 4A's message says "[r]ecent double-blind placebo-controlled study finds Norvcsc increases..." and a question: "[w]ould you like to receive information on Norvcsc in your email?" The

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[66] Claim 45.
[67] See argument above.
[68] Claim 45.
[69] Application specification page 21, line 5, emphasis added.

message then includes buttons "yes" or "no" which the physician can select.[70] Selecting "yes" will take the physician to a screen like Figure 4B stating that more information will come with the next synchronization. Selecting "no" means the physician will not be sent more information. This easy and quick interaction allows the physician to quickly and easily keep abreast of information of particular interest to that physician.

1. Falchuk does not teach "at a server...generating an interactive message comprising: ...including objects that physicians in the group can select to respond to, or dispose of, the interactive message."

Independent claim 45 includes the following element "at a server...generating an interactive message comprising: ...including objects that physicians in the group can select to respond to, or dispose of, the interactive message."

The Examiner does not rely on Falchuk as disclosing this element. In fact the Examiner states, "Falchuk does not explicitly disclose interactive message comprising: including objects that the physicians (or users) can select to respond to, or dispose of, the interactive message."[71]

Falchuk discloses sending requests from the individual primary care physician to the specialist routed through the supervisory host attended by a staff physician.[72] Falchuk also discloses sending "selected materials" which may be relevant to the request.[73]

These messages are normal e-mail type messages, which do not contain interactive components such as buttons for selection. These messages are processed by a staff physician, not by the server. Furthermore, as stated above, the information is for one primary physician or one specialist, not for a group. Therefore, Falchuk does not teach "at a server...generating an interactive message comprising:... including objects that physicians in the group can select to respond to, or dispose of, the interactive message.

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[70] Application specification Figures 4A.
[71] Office Action, page 4.
[72] Falchuk, Col. 5, lines 12-52.
[73] Falchuk, Col. 5, lines 47-52.

2.   Bauer does not teach "at a server...generating an interactive message comprising: ...including objects that physicians in the group can select to respond to, or dispose of, the interactive message."

Independent claim 45 includes the following element "at a server...generating an interactive message comprising: ...including objects that physicians in the group can select to respond to, or dispose of, the interactive message." The Examiner does not cite Bauer as teaching this element.

Bauer teaches synchronization between a client and a server, which are not in continuous connection.[74] Bauer teaches that the database with the client and the server share is restored to consistency during a synchronization process.[75]

Bauer does not teach sending or receiving any "messages" containing "objects" that can be selected by a user. Although communications between the client and the server occur, they are synchronization communications for updating a database, not messages with interactive components, such as selectable objects. Also, they are sent only to and from one client and server at a time, not to and from a group. Therefore, Bauer does not teach "at a server...generating an interactive message comprising: ...including objects that physicians in the group can select to respond to, or dispose of, the interactive message."

3.   Pang does not teach "at a server...generating an interactive message comprising: ...including objects that physicians in the group can select to respond to, or dispose of, the interactive message."

Independent claim 45 includes the following element "at a server...generating an interactive message comprising: ...including objects that physicians in the group can select to respond to, or dispose of, the interactive message."[76] The Examiner cites Pang; Column 3, lines 19-62, and figure 5, items 514, 519 for teaching this element.[77]

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[74] Bauer, Abstract.
[75] Bauer, Col. 1, lines 50-52.
[76] Claim 45.
[77] Office Action, page 4.

Pang discloses "a novel method for replying to unsolicited e-mail communications such as SPAM and the like."[78] In Pang's taught method, a selectable icon called "NO SPAM" is displayed <u>near</u> the list of e-mail messages or <u>near</u> the content of message itself.[79] If the e-mail user determines that a message is SPAM and clicks on the "NO SPAM" icon, specific actions occur.[80] It should be noted that Pang specifically states that the "NO SPAM" button is "<u>disposed around the periphery of the graphical user interface</u>." Pang further states that "[t]he periphery of the graphical user space is <u>outside of the region for the main text</u> or body of the e-mail message."[81] The other buttons of Pang such as the "reply," "forward," and "delete" buttons are likewise outside of the region for the body of the e-mail message as shown in Pang, Figure 5.

The buttons of Pang are not, <u>included in the interactive message</u>, but are instead located "<u>outside the region for the main text</u> or body of the e-mail message." Therefore, contrary to the Examiner's arguments, although Pang does disclose "buttons," they are not the claimed "objects" of claim 45 because they are not <u>included</u> in the interactive message. Furthermore, the message is not generated "<u>at a server</u>." Pang's taught buttons are part of the email software, *i.e.*, the buttons are not a part of the e-mail message at all. Therefore, Pang does not teach (1) generating any <u>messages at the server</u>, and thus cannot teach (2) generating <u>interactive</u> messages at the server, and therefore further cannot teach (3) generating interactive messages that include <u>selectable objects</u> at the server.

The difference between Pang's buttons and the claimed "included objects" is significant. Where and when an interactive button is generated is not a trivial change. The specification explains that the interactive messaging system provides relevant and customized information in a format that makes it easy for the practitioner to quickly and easily process.[82] These messages are short, preferably not more than a single screen for effectiveness.[83] To keep from being overwhelmed, the physician will receive only up to a set maximum number of informational

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[78] Pang, Abstract.
[79] Pang, Col. 7, line 42 – Col. 8, line 22.
[80] Pang, Col. 7, lines 57-67 and Col. 8, lines 16-22.
[81] Pang, Col. 45-48, emphasis added.
[82] Application specification page 21, line 20- page 22, line 3.
[83] Application specification page 21, lines 9-10.

messages.[84] The physician can choose to read the messages immediately or at a later time.[85] In keeping with the concept of easy processing of interactive messages, the interactive buttons/objects are included inside the original interactive message. As can be seen in Figures 4A-4D, the included objects (For example, buttons labeled "yes" and "no" in Figure 4A) are displayed on the screen with the message itself. This allows for a busy practitioner with a hand-held device to quickly request more information or dispose of the interactive message. Pang's buttons only facilitate well known email features, and do not teach any of the particular advantages made possible by the present claims as the objects are not included in an interactive message.

Therefore, for the above stated reasons Pang does not teach "<u>at a server</u>...generating an <u>interactive message</u> comprising: ...including <u>objects</u> that physicians in the <u>group</u> can select to respond to, or dispose of, the interactive message."

E.   Falchuk, Bauer, and Pang do not teach "receiving, at the server, a synchronization signal from a respective handheld computing device operated by a respective physician of the group of physicians."

Independent claim 45 includes the following element "receiving, at the server, a synchronization signal from a respective handheld computing device operated by a respective physician of the group of physicians."[86]

The Examiner correctly notes, Falchuk does not disclose "receiving, at a server, a synchronization signal from a respective handheld computing device."[87] The Examiner cites Bauer abstract, Column 1, line 59 to Column 2, line 5, Column 3, lines 1-11, Column 6, lines 13-21, and Column 11, lines 17-35 for teaching this element.[88]

Independent claim 45 recites "receiving, at the server, a synchronization signal from a respective handheld computing device <u>operated by a respective physician of the group of</u>

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[84] Application specification page 20, lines 28-29.
[85] Application specification page 20, lines 30-31.
[86] Claim 45.
[87] Office Action, page 3
[88] Office Action, page 4.

physicians." The Examiner does not address the claim language that states the synchronization signal is "operated by a respective member of the group of physicians." All words in a claim must be considered in judging the patentability of that claim against the prior art. *See*, MPEP § 2143.03 citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In addition, MPEP §2116 provides that the materials on which a process is carried out must be accorded weight in determining the patentability of a process. Thus, the claim language "operated by a respective one of said identified physicians" must be considered. Bauer does not disclose "receiving, at the server, a synchronization signal from a respective handheld computing device operated by a respective member of the group of physicians" because it does not discuss physicians at all.

Furthermore, this missing element of Bauer cannot be cured by Pang which also fails to mention physicians. Although Falchuk discusses physicians, it too cannot cure Bauer's missing element. Falchuk does not teach "a respective member of the group of physicians" because, as discussed in detail above, Falchuk only processes a message from a single physician to a single specialist. Falchuk does not identify a group. Therefore, Falchuk cannot teach a respective member of a group of physicians. For at least these reasons, Bauer, Pang, and Falchuk do not teach, "receiving, at the server, a synchronization signal from a respective handheld computing device operated by a respective member of the group of physicians."

F.   Falchuk, Bauer, and Pang do not teach "in response to said synchronization signal, automatically transmitting said interactive message from the computer system to said respective handheld computing device."

Independent claim 45 includes the following element "in response to said synchronization signal, automatically transmitting said interactive message from the computer system to said respective handheld computing device."[89] The Examiner does not cite any particular language of Falchuk, Bauer, or Pang for teaching this element.

These references cannot teach this element because, as stated above none of them teach an "interactive message." The interactive message referred to in this element is that described in

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[89] Claim 45.

earlier elements of the claim, namely the interactive message comprises "customizing at least a portion of said medical information stored on the computer system to said identified group" and "including objects that physicians in the group can select to respond to, or dispose of, the interactive message." For the reasons stated above none of the cited references teach either of these elements. Therefore, they cannot teach "in response to said synchronization signal, automatically transmitting said interactive message from the computer system to said respective handheld computing device."

G. Falchuk, Bauer, and Pang do not disclose the elements of dependent claim 46

For the reasons stated above, independent claim 45 is patentable over Falchuk, Bauer, and Pang. As a result, all of the dependent claims are patentable over these references for at least the same reasons. Furthermore, claim 46 is independently patentable over these references for additional reasons. Dependent claim 46 recites, *inter alia*, that "said identifying is based on information selected from the group consisting of: a practice area of each respective physician of the group of physicians; a number of prescriptions written by each respective physician; a Drug Enforcement Agency number of each respective physician; a medical education number of each respective physician; and any combination of the aforementioned."[90] This claim is supported by the specification that states, "[p]hysicians may be identified by their practice areas, number of prescriptions written or even their Drug Enforcement Agency Number (DEA#), or Medical Education Number (ME#)."[91]

The Examiner does not rely on Bauer or Pang for this element, as neither of these references teach working with physicians, let alone identifying a subset by physician specific characteristics. The Examiner cites Falchuk, Column 3, lines 47-52 and Column 5, lines 48-54 as disclosing this element.[92] Neither of these citations discusses identifying a group of physicians, as is required by claim 46. The Column 3 citation discusses that a staff physician selects a specialist. There is no mention that any of the criteria would be used for this selection. The Column 5 citation discusses how a physician may receive continuing medical education

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[90] Claim 46.
[91] Application specification page 21, lines 20-22.
[92] Office Action, page 6.

(CME) credits through Falchuk's system. It also makes no mention of using any of the <u>criteria</u> for receiving CME credits. In other words, these cited columns do not discuss DEA numbers, ME numbers, number of prescriptions written, or even practice areas as the criteria used for making any selections. They further do not use any criteria for identifying a <u>group</u> of physicians. Therefore, Falchuk fails to teach, "said identifying is based on information selected from the group consisting of: a practice area of each respective physician of the group of physicians; a number of prescriptions written by each respective physician; a Drug Enforcement Agency number of each respective physician; a medical education number of each respective physician; and any combination of the aforementioned."

H.   Falchuk, Bauer, and Pang do not disclose the limitations of dependent claim 51

For the reasons stated above, independent claim 45 is patentable over Falchuk, Bauer, and Pang. As a result, all of the claims that depend from claim 45 are also patentable over these references for at least the same reasons. Furthermore, claim 51 is independently patentable over these references for additional reasons. Dependent claim 51 recites, *inter alia*, that "the interactive message includes <u>an inquiry</u> about whether said physicians wish to receive Continuing Medical Education (CME) at the handheld computing device."[93]

Bauer and Pang do not mention anything about Continuing Medical Education, and therefore cannot teach this element. In the current Office Action, the Examiner states that Falchuk Column 5, lines 48-58 teaches this element.[94] However, in the Office Action mailed February 7, 2007, the Examiner expounded upon this position stating that:

> in col. 5, lines 48-48, Falchuk teaches that the physician is entitled to CME credits based on his/her participation and Falchuk continues in col. 6, lines 11-27 that the primary care physician may request the display of his/her participation in prior consultations to obtain information on earned CME credits. <u>Examiner considers that the physician wishes to receive CME.</u> Also, in col. 5, lines 35-47 Falchuk teaches with an incoming message the physician may request a clarification or may conclude the consultation, and a CME accreditation module indicated generally at 70 is notifies [sic] that the consultation has been successfully concluded. <u>Examiner considers that when the physician concludes</u>

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[93] Claim 51.
[94] Office Action, page 6.

the consultation, that means he/she no longer wishes to receive CME. (Emphasis added.)

The only request disclosed is a request by the physician for a display of the physician's prior participation in consultations. Falchuk does not teach including an inquiry in an interactive message (generated at a server) asking whether the primary care physician wishes to receive CME. The Examiner interprets certain portions of Falchuk as implying that the physician either does or does not wish to receive CME. The wishes of the physician, however, do not form any part of claim 51. Falchuk only discloses that Continuing Medical Education credits are automatically provided with consultations. As such, claim 51 is patentable over Falchuk as Falchuk does not teach "the interactive message includes an inquiry whether said physicians wish to receive Continuing Medical Education (CME) at the handheld computing device," as required by the claim.

I.   Falchuk, Bauer, and Pang do not disclose the limitations of dependent claim 57

For the reasons stated above, independent claim 45 is patentable over Falchuk, Bauer, and Pang. As a result, all of the claims that depend from claim 45 are also patentable over these references for at least the same reasons. Furthermore, claim 57 is independently patentable over these references for additional reasons. Dependent claim 57 recites, *inter alia*, that "said generating further comprises associating an expiration date with said interactive message, such that said interactive message expires after a predetermined time and is thereafter removed from said respective handheld computing devices."[95] This claim is supported by the specification which states that "[e]ach message may also have an expiration date. If a message expires before a physician has read it, it will be automatically deleted from the PDA."[96] Such a feature is especially helpful where memory on the PDA is at a premium.[97]

The Examiner does not rely on Bauer or Pang for this element, as neither of these references disclose messages with expiration dates. Instead, the Examiner cites to Falchuk,

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[95] Claim 57.
[96] Application specification page 21. lines 18-19.
[97] Application specification page 20, lines 28-29.

column 4, lines 53-61 as purportedly disclosing this element.[98] This cited paragraph of Falchuk discloses that a <u>staff physician</u> is notified if a request for consultation is not handled in a timely fashion by the selected specialist.[99] The staff physician may then <u>select a different available specialist</u> to handle the request.[100]

The claimed "generating" is dependent on claim 45, which requires that the interactive message be generated at the <u>server</u>. Falchuk does not disclose "generating" at the server, because the <u>staff physician,</u> not the server, handles the delayed responses. Furthermore, Falchuk does not teach <u>removing</u> messages. For at least these reasons Falchuk does not teach, "said generating further comprises associating an expiration date with said interactive message, such that said interactive message expires after a predetermined time and is thereafter removed from said respective handheld."

J.   Falchuk, Bauer, and Pang do not disclose the limitations of dependent claim 61

For the reasons stated above, independent claim 45 is patentable over Falchuk, Bauer, and Pang. As a result, all of the claims that depend from claim 45 are also patentable over these references for at least the same reasons. Furthermore, claim 61 is independently patentable over these references for additional reasons. Dependent claim 61 recites, *inter alia*, that the "handheld computing device is configured to store a set maximum amount of messages at any one time."[101] This claim is supported by the specification that states, "[a] set maximum amount of messages are stored at any one time on the PDA"[102] and "[b]etween each synchronization session, the physician will preferably never have to view more than the set maximum amount of messages stored on the PDA."[103]

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[98] Office Action, page 8.
[99] Falchuk, Col. 4, lines 53-57.
[100] Falchuk, Col. 4, lines 58-61.
[101] Claim 61.
[102] Application specification page 20, lines 28-29.
[103] Application specification page 21, lines 3-4.

The Examiner states that neither Falchuk nor Pang disclose this element.[104] Instead, the Examiner cites to Bauer, column 1, lines 51-58; column 3, lines 1-11; column 4, lines 12-25; column 6, lines 13-21; and column 11, lines 17-35 as disclosing this element.[105] However, as will be shown below, Bauer does not teach the limitations of claim 61. Instead, Bauer teaches that the database with the client and the server share is restored to consistency during a synchronization process.[106] Bauer does not teach anything about a maximum amount of interactive messages being stored on the handheld computing device at a time. At most Bauer teaches that "synchronization costs are reduced by a message structure which minimizes the length of data messages transmitted."[107] Bauer accomplishes this by specifying a minimal amount of information necessary to modify a row of the database.[108] In other words, Bauer still sends all information between a client and a server, but does so in such a way as to be efficient by sending only the minimal amount of information necessary. Therefore, Bauer does not teach that the "handheld computing device is configured to store a set maximum amount of messages at any one time."

K. Claim 45 Is Also Not Obvious Because Of Secondary Considerations

When determining whether an obviousness rejection is appropriate, the Patent and Trademark Office must give secondary considerations due weight. *In re Sernaker*, 702 F.2d 989 (Fed. Cir. 1983). Secondary considerations include commercial success, long felt but unresolved needs, and failure of others. *Graham v John Deere Co.*, 383 U.S. 1 (1966). Secondary considerations should be considered in every case for whatever probative value they have and are not limited to cases where patentability is a close question. *Stratoflex, Inc., v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). Evidence of secondary considerations may often be the most probative and cogent evident in the record as secondary considerations may often establish that an invention appearing to have been obvious in light of the prior art is not. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopedics, Inc.*, 976 F.2d 1559 (Fed. Cir. 1992.)

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[104] Office Action, page 10.
[105] Office Action, page 10.
[106] Bauer, Col. 1, lines 50-52.
[107] Bauer, Col. 3, lines 1-4.
[108] Bauer, Col. 3, lines 4-7.

The Appellant, Epocrates Inc., was founded in 1998. Epocrate's software offerings, including Epocrates Essentials®, Epocrates Rx Pro®, or Epocrates Rx®, include a feature called DocAlert®. The DocAlert® feature practices at least independent claim 45 of the present application. For further information on Epocrate's DocAlert® feature see http://www.epocrates.com/products/docalert/.

Due to the popularity of its product features, including DocAlert®, Epocrates has experienced tremendous commercial success since its founding. More than 500,000 health care professionals are customers. Epocrates' customers in the United States include 1 in 4 physicians and 1 in 3 medical students.[109] More that 50% of physicians using Epocrates' products believe that they have avoided at least one adverse drug event or medical error a week.[110] Additionally, more than 90% of physicians reported that using a mobile device loaded with Epocrates software helps them provide better patient care.[111] Furthermore, numerous sponsors and well known drug companies, like Pharmacia, have chosen to use the DocAlert® feature to send clinical information to physicians. *See Pharmacia Messages Physicians Using ePocrates DocAlert(R) Program*, PR Newswire April 2, 2002 (attached). As such, the commercial success of DocAlert® provides further evidence that at least claim 45 is not obvious over the cited art.

In addition, at least claim 45 is also not obvious because of other secondary considerations including <u>long felt but unresolved needs</u> and the <u>failure of others</u>. As stated in the specification, despite the growth of the health care sector in general and the health information system industry in particular, an information system which satisfies the needs and wants of physicians had not been developed.[112] Most previous applications seeing to address the needs of physicians were designed for a desktop or tablet computer.[113] These solutions fail to recognize that physicians are not desk-bound.[114] The inadequacies of these applications and their hardware platforms have restricted their use by physicians, which, in turn, has prevented the population of

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[109] *See* http://www.epocrates.com/company/mediaroom/mediaresources/statistics.html
[110] *Id.*
[111] *Id.*
[112] Application specification page 1, lines 16-18.
[113] Application specification page 5, lines 6-7.
[114] Application specification page 5, lines 7-8.

clinical databases which could be used for decision support.[115] Furthermore, Contract Research Organizations often have difficulty reaching physicians to undertake clinical trials of new drugs on their patients.[116] Additionally, managed care organizations have trouble reaching physicians, for example, to inform them of changes in the industry.[117] Likewise, health care websites, while providing helpful health care information tend to experience low traffic by busy physicians.[118] These needs were long felt recognized problems by physicians and health care related industries. However, the desktop and/or laptop solutions provided to physicians failed to solve these recognized needs.

As such, it is respectfully submitted that the long felt but unresolved needs and failure by others to provide a usable platform to help busy physicians stay abreast of changing medical information, was not adequately addressed until the introduction of the Epocrates' DocAlert® system. Therefore, Appellants respectfully submit that in addition to the technical arguments raised above with respect to the cited references not teaching the claimed invention, secondary considerations, which must be given due weight, provide strong evidence supporting the patentability of the pending claims.

L. Conclusion

The present invention provides an unprecedented level of ease of use to a particularly important yet overworked sector of the population – physicians. Because a physician receives only messages customized to his/her group of physicians, and because the messages are small and easy to deal with, a physician can quickly and easily stay abreast of current relevant medical information. If the physician of the group of identified physicians is interested in learning more, he/she can request more information, if not he/she can dispose of the interactive message and will not be bothered with it again. Furthermore, because these customized and easy to deal with messages come to a physician's hand-held device, he/she can stay abreast of current and relevant information at the point of patient care. The physician is not forced to spend valuable time

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[115] Application specification page 5, lines 8-10.
[116] Application specification page 6, lines 16-29.
[117] Application specification page 6, line 32 – page 7, line 4.
[118] Application specification page 7, lines 18-23.

wading through large amounts of information on paper, on a desktop computer e-mail system, or on a website. The interactive messages are also often small, preferably not more than a single screen, including the interactive buttons. In this way, interactive messages can be quickly and easily dealt with by a busy physician.

In summary, Appellants have demonstrated that the § 103 rejections of independent claim 45 cannot be sustained because Falchuk, Bauer, and Pang, either alone or in combination, do not teach the following claim limitations: "at a server in said computer system: identifying a group of physicians from multiple physicians", "at a server...generating an interactive message comprising: customizing at least a portion of said medical information stored on the computer system to said identified group", "at a server...generating an interactive message comprising: ...including objects that physicians in the group can select to respond to, or dispose of, the interactive message", "receiving, at the server, a synchronization signal from a respective handheld computing device operated by a respective physician of the group of physicians", and "in response to said synchronization signal, automatically transmitting said interactive message from the computer system to said respective handheld computing device." As all of the dependent claims depend from independent claim 45, Appellants submit that for at least the above stated reasons claims 45-61, 63, 64, 66, and 89-91 are patentable over the cited art.

In view of the foregoing, Appellants respectfully request. allowance of the pending claims 45-66 and 89-91, especially in light of the extreme length of time since filing.

If any other fees are due in connection with the filing of this Brief, please charge the fees to Morgan, Lewis & Bockius LLP Deposit Account No. 50-0310 (order No. 61018-0007-US). Likewise, if a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should be charged to the same account number.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: July 11, 2008
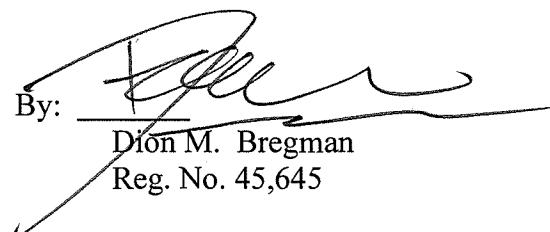
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VIII. Claims Appendix

CLAIMS CURRENTLY ON APPEAL ORDERED BY NUMBER

1. - 44. (Canceled)

45. (Previously Presented) A method for distributing medical information stored on a computer system to a group of physicians, the method comprising:

at a server in said computer system:

identifying a group of physicians from multiple physicians;

generating an interactive message comprising:

customizing at least a portion of said medical information stored on the computer system to said identified group; and

including objects that physicians in the group can select to respond to, or dispose of, the interactive message;

receiving, at the server, a synchronization signal from a respective handheld computing device operated by a respective physician of the group of physicians, wherein said synchronization signal indicates an availability of said respective handheld computing device for receipt of said interactive message; and

in response to said synchronization signal, automatically transmitting said interactive message from the computer system to said respective handheld computing device.

46. (Previously Presented) The method of claim 45, wherein said identifying is based on information selected from the group consisting of: a practice area of each respective physician of the group of physicians; a number of prescriptions written by each respective physician; a Drug Enforcement Agency number of each respective physician, a medical education number of each respective physician, and any combination of the aforementioned.

47. (Previously Presented) The method of claim 45, wherein said identifying is based on a medical education number of each respective physician of said group of physicians.

48. (Previously Presented) The method of claim 45, further comprising, after said identifying, examining respective profiles of each respective physician of the group of physicians, wherein said interactive message is customized based on said respective profiles.

49. (Previously Presented) The method of claim 45, wherein the interactive message includes an interactive question directed to the physicians in the group.

50. (Previously Presented) The method of claim 45, wherein the interactive message includes a question asking the respective physician of the group of physicians if the respective physician would like further information on a certain medical topic.

51. (Previously Presented) The method of claim 45, wherein the interactive message includes an inquiry whether said physicians wish to receive Continuing Medical Education (CME) at the handheld computing device.

52. (Previously Presented) The method of claim 51, wherein the Continuing Medical Education includes educational materials or multiple choice exams.

53. (Previously Presented) The method of claim 45, further comprising, after said transmitting, receiving a response from said respective physician of said group of physicians.

54. (Previously Presented) The method of claim 53, further comprising, sending further medical information to said respective physician of the group of physicians based on said response.

55. (Previously Presented) The method of claim 45, wherein the interactive message includes an inquiry whether said physicians wish to receive Continuing Medical Education (CME) at respective handheld computing devices, and said method further comprises, after said transmitting, receiving a response from said respective physician of said group of physicians, and transmitting CME educational materials or multiple choice exams to said respective handheld computing device operated by said respective physician of said identified group of physicians if

said response indicated that said respective physician of said group of physicians wishes to receive Continuing Medical Education (CME).

56. (Previously Presented) The method of claim 45, wherein said generating further comprises associating an expiration date with said interactive message, such that said interactive message expires after a predetermined time.

57. (Previously Presented) The method of claim 45, wherein said generating further comprises associating an expiration date with said interactive message, such that said interactive message expires after a predetermined time and is thereafter removed from said respective handheld computing devices.

58. (Previously Presented) The method of claim 45, wherein said interactive message is configured to be automatically displayed to said respective physician of said identified group of physicians once downloaded to said respective handheld computing device.

59. (Previously Presented) The method of claim 45, wherein said receiving further comprises receiving, from said respective handheld computing device, an amount of interactive messages stored on said respective handheld computing device; and if said amount is above a maximum amount, storing said interactive message on the server instead of transmitting said interactive message to said respective handheld computing device.

60. (Previously Presented) The method of claim 45, further comprising repeating said generating and transmitting steps for multiple interactive messages.

61. (Previously Presented) The method of claim 45, wherein said respective handheld computing device is configured to store a set maximum amount of messages at any one time.

62. (Previously Presented) The method of claim 45, further comprising prioritizing the interactive message by a category selected from the group consisting of: an expiration date, importance, and urgency.

63. (Previously Presented) The method of claim 45, further comprising:

storing medical data in a database on the server; and

communicating at least some of said medical data from said database to said respective

handheld computing device in response to a connection signal received from said respective

handheld computing device.

64. (Previously Presented) The method of claim 63, further comprising, before said

storing, aggregating said medical data from multiple sources.

65. (Previously Presented) The method of claim 64, wherein said aggregating step further

comprises collecting medical data from a group consisting of: formulary data, pharmacopeia

data, and any combination of the aforementioned.

66. (Previously Presented) The method of claim 63, wherein said communicating said

medical data further comprises:

receiving a request for medical data from said respective handheld computing device; and

responding to the request by sending at least a portion of said medical data to said

respective handheld computing device.

67. - 88. (Withdrawn)

89. (Previously Presented) The method of claim 48, wherein examining the profile

includes examining, for each physician of the identified group of physicians, count data, said

count data recording access time and frequency, and input data, said input data tracking all input

for each physician of the identified group of physicians.

90. (Previously Presented) The method of claim 45, wherein the objects include answers

each respective physician of the identified group of physicians can select without typing text.

91. (Previously Presented) The method of claim 45, including, after said transmitting,

receiving, in response to a second synchronization signal, a selection of a negative response object or a positive response object in the interactive message, wherein the selection is one click on either the negative response object or the positive response object.

IX. Evidence Appendix

For this appeal, Appellants do not rely on any evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, or other evidence entered by the Examiner.

X.   Related Proceedings Appendix

Appellants are not aware of any related proceedings.

1 of 1 DOCUMENT

PR Newswire

April 2, 2002 Tuesday

SECTION: FINANCIAL NEWS

DISTRIBUTION: TO BUSINESS, MEDICAL AND TECHNOLOGY EDITORS

LENGTH: 384 words

HEADLINE: Pharmacia Messages Physicians Using ePocrates DocAlert(R) Program;
Point-of-Care Program Targets Physicians by Specialty

DATELINE: SAN CARLOS, Calif. April 2

BODY:

ePocrates -- the largest handheld network of physicians -- announced today that Pharmacia is sending clinical information to physicians in the ePocrates network using DocAlerts. The ePocrates DocAlert program allows pharmaceutical companies to deliver short messages directly to physicians' PDAs at the point of care and allows them to request additional information directly from their handheld devices.

"DocAlert messaging is an excellent way for pharmaceutical brand managers to target physicians at the point of care, by specialty and with exclusivity," says Jeff Tangney, co-founder and vice president of business development at ePocrates.

Currently one out of four doctors -- and more than 250,000 other clinicians including physician assistants, nurse practitioners, pharmacists, dentists, RNs-are part of the ePocrates network.

Every day, over 30,000 clinicians receive DocAlert clinical updates on their handheld devices when they update their ePocrates databases over the Internet.

All DocAlert messages from pharmaceutical companies are displayed alongside high-quality clinical news from respected medical organizations such as the FDA MedWatch, Institute for Safe Medication Practices (ISMP) and the Center for Disease Control. ePocrates DocAlert topics also include practice management tips, findings from evidence-based medicine and updates to the drug database.

To date, ePocrates has signed partnerships with 7 of the 10 leading pharmaceutical companies.

About ePocrates

ePocrates Inc. is the largest handheld physician network with over 500,000 users. In addition to the ePocrates Rx(TM) clinical drug database, ePocrates also offers ePocrates ID(TM), ePocrates Rx Formulary (TM), DocAlert(R) messaging and ePocrates Honors(TM), a physician recruitment tool.

Headquartered in San Carlos, CA, ePocrates is a privately held company led by president and CEO John Voris, former COO of PCS and veteran of Eli Lilly. The company was founded in 1998 by Richard Fiedotin, MD and Jeff

Tangney and is funded by Sprout Group, Bay City Capital, Draper Fisher Jurvetson, InterWest and Three Arch Partners.
For more information on ePocrates, visit www.epocrates.com.

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